REMARKS

The Examiner is thanked for the performance of a thorough search. By this response, no claims have been amended or canceled. Claim 29 has been added. Hence, Claims 1–29 are pending in this application.

All issues raised in the Office Action are addressed hereinafter.

I.   CLAIM REJECTIONS BASED ON 35 U.S.C. § 103

Claims 1–28 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 7,202,972 (hereinafter "*Schwier*") in view of U.S. Patent No. 6,078,403 to Palmer (hereinafter "*Palmer*"). Applicants traverse the rejection. Reconsideration is respectfully requested.

INDEPENDENT CLAIM 1

Claim 1, as set forth in the listing of claims, clarifies that the method features:

> receiving, at a merge utility executing on a computer system, **a first merge document that is in a merge format**;
> converting a second document from an original format to the merge format to create a second merge document;
> . . .
> wherein the **second merge document is in the merge format**;
> **using the merge utility** executing **on the computer system, merging the first merge document and the second merge document** to generate a composite merge document; and
> **after generating** the composite merge document, **delivering said composite merge document to an output device**;
> . . .
> wherein **the merge format is a format that is supported by the output device**, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device.

At least the above-bolded features are neither taught nor suggested by the cited references, for at least the reasons discussed below.

(1) <u>The references are inoperable in combination</u>

The Office Action alleges that one skilled in the art would have had motivation to combine *Palmer* and *Schwier*. The Office Action is mistaken. The technique described in *Palmer* is incompatible with the technique described in *Schwier*. In fact, *Schwier* explicitly teaches away from *Palmer*'s technique.

In *Palmer*, a "base document 44" and "document definition file 46" are combined with a "variable data file 48" to form a "merged document 52." *Palmer* at FIG. 2. The merged document 52 is then sent to the "printer 12."

Meanwhile, *Schwier* teaches to divide a document 13 into a "static part 16" and "variable part 15" prior to sending the data to the printer "in order to avoid a redundant repetition of the static data." *Schwier* at col. 6, lines 14–23. The static data 16 and variable data 15 are "separately transmitted" to the printer device 7. *Schwier* at col. 6, lines 49–53. The printer saves the static data 16 in its main memory 8 for future use. *Schwier* at col. 6, lines 33–35. Any time the computer prints a subsequent document with the same static data 16, the computer "discards" and does not transmit the static data 16 to the printer 7 since the printer 7 already has the static data 16. *Schwier* at col. 6, lines 65–col. 7, line 1. The static data 16 and the variable data 15 are then merged at the printer 7. *Schwier* at col. 7, lines 4–6.

Palmer is incompatible with *Schwier* because while *Palmer* teaches to send a merged version of variable and static data to a printer, *Schwier*'s invention specifically requires that static data and variable data **not be merged** before being sent to the printer. Explains *Schwier*, "a **logical discrimination (separability) between the data <u>must</u>** be retained." *Schweir* at col. 6, line 55–56. The separation of variable and static data is essential to achieve "a considerable reduction of the data stream between the computer system 1 and the printer system 7 is achieved." *Schweir* at col. 6, line 59–61.

Thus, modifying *Schweir* to incorporate *Palmer*'s technique would entirely frustrate the purpose of *Schweir*'s invention. One skilled in the art would have every reason **not** to combine *Palmer* and *Schwier*. Therefore the alleged combination would not teach one skilled in the art any aspect of Claim 1.

    (2) <u>*Palmer*'s document definition file is not a "document" within the meaning of Claim 1</u>

Even if the alleged combination would have been possible, *Palmer* fails to teach "using the merge utility executing on the computer system, merging the **first merge document** and the **second merge document** to generate a composite merge document."

In *Palmer*, a "base document 44" and a "document definition file 46" are merged by a "post processor 50" to form a "merged document 52." The Office Action appears to allege that the post processor 50 corresponds to Claim 1's "merge utility" and that the "merged document 52" corresponds to "composite merge document" of Claim 1. It is not clear, however, to which of Claim 1's first and second merge documents the "base document 44" and "document definition file 46" are alleged to correspond.

Nonetheless, *Palmer* says nothing about either the "base document 44" or a "document definition file 46" being in a "merge format," as Claim 1 requires of the first and second merge documents. To be in a "merge format" within the meaning of Claim 1, a document must be in a "**format that is supported by the output device**, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device." However, *Palmer* gives absolutely no indications regarding the format of the base document 44 and the document definition file 46 at the time they are received by the alleged merge utility, post-processor 50.

Furthermore, one skilled in the art would not interpret a "document definition file 46" to be a "document." The document definition file 46 appears to contain no substance. Rather, the document definition file appears to be nothing more than a compilation of the various "format parameters" hidden with the variable data areas of the base document 44. *See Palmer* at col. 7, lines 18–20, 30–35.

For at least the above reasons, *Palmer* does not teach or suggest "using the merge utility executing on the computer system, merging the **first merge document** and the **second merge document** to generate a composite merge document" within the meaning of Claim 1.

    (3) <u>EMF is not a merge format within the meaning of Claim 1</u>

The Office Action appears to persist in its belief that EMF is a merge format within the meaning of Claim 1. For example, the Office Action alleges that *Schwier* at FIG. 2, by virtue of

V+S (EMF) 12, discloses "merging the first merge document and the second merge document to generate a composite merge document." Since Claim 1 recites that each of the first merge document and the second merge document must be "in a merge format," the Office Action implicitly alleges that Variable Data V and Static Data S—each of which are in the EMF format—are in the merge format. *See* col. 6, lines 11–14. Thus, the Office Action alleges that EMF is the merge format of Claim 1.

However, **EMF cannot be the merge format of Claim 1**. The merge format of Claim 1 is recited to be "a **format that is supported by the output device**, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device." One skilled in the art would clearly understand that **no output device "supports" EMF, and that EMF must be converted into another format before being sent to an output device**. *Schwier* admits as much in col. 9, lines 14–22, when *Schwier* describes how EMF must be converted to "a RAW data stream," such as PCL, in order for it to be "supplied to the destination printer device."

Strangely enough, the Office Action cites to this same section of *Schwier* in explaining its allegation that *Schwier* nonetheless discloses that the merge format "is supported by the output device." The Office Action has clearly misread this section. EMF is sent to the spooler 50, which, as one skilled in the art would understand, is not on the printer. The stream **must** be converted to PCL (the RAW data stream) by either the spooler 50 or the converter unit 58 prior to reaching printer 52.

For at least the above reasons, *Schwier* fails to teach or suggest a number of elements of Claim 1, including "receiving, at a merge utility executing on a computer system, a first merge document that is in a merge format," "converting a second document from an original format to the merge format to create a second merge document," and "merging the first merge document and the second merge document to generate a composite merge document."

(4) No "combined document" is ever delivered to *Schwier*'s printer

The Office Action also apparently misunderstands *Schwier*'s FIGs. 8 and 9. The Office Action bases its allegation that *Schwier* teaches "delivering said composite merge document to an output device" on these figures, apparently under the impression that these figures illustrate the delivery of a combined V+S (EMF) 13 to a printer. Yet, neither of these documents teaches

that a combined document is sent to *Schwier*'s printer. Rather, as depicted in *Schwier* at FIG. 2
and explained in *Schwier* at col. 6 (discussed in section (1) above), *Schwier* requires that V+S
(EMF) 13 be split into separate parts and then delivered to the printer separately. *Schwier* uses
FIGs. 8 and 9 solely to illustrate how the separate parts get to the printer.

FIG. 8 merely shows how a conventional document is printed in the Windows
environment. In fact, *Schwier* implies that his invention cannot use the technique described in
FIG. 8. *Schwier* at col. 9, lines 46–50 (stating that *Schwier*'s invention relies on the "inventively
modified driver" of FIG. 9 instead of on the technique of FIG. 8). Thus, **Schwier teaches away
from FIG. 8**.

The purpose of FIG. 9, meanwhile, is to illustrate *Schwier*'s "inventively modified
driver." *Id.* This **"inventively modified driver"** is none other than the "EMF spooling . . .
implemented via a Windows printer driver" **on which Schwier relies to separate the static part
16 and variable part 15**. *Schwier* at col. 6, lines 14–15. *Schwier* makes no statement in
connection with FIG. 9 to lead one skilled in the art to believe that FIG. 9 illustrates a combined
document being delivered to a printer.

For at least the foregoing reason, the combination of *Palmer* and *Schwier* fails to teach or
suggest at least one feature of independent Claim 1. Therefore, the combination of *Palmer* and
Schwier does not render Claim 1 obvious under 35 U.S.C. § 103. Reconsideration is respectfully
requested.

CLAIM 11

Claim 11 recites that "the composite merge document is in the merge format." Thus, as
defined by Claim 11, a composite merge document must be in the merge format, and must be
delivered to the output device. The Office Action alleges that such a composite merge document
is disclosed in *Schwier* at col. 3, lines 56-67. The Office Action is mistaken. These lines merely
describe how a single document containing variable and static data is converted to EMF format
(a non-merge format) that is subsequently separated into two documents prior to being converted
to PCL (a merge format).

Even if the relied upon lines did disclose that "the composite merge document is in the
merge format," **the Office Action would be inconsistent**. Claim 1 recites that the "merge
utility" "receive[es] . . . a first merge document that is in a merge format." Claim 11 recites that

"a composite merged document" is delivered to an output device "in the merge format." Thus, Claim 11 requires that **the merge utility receives at least one document <u>in the same format</u> as does the output device**.

As mentioned with respect to Claim 1, *Schwier* teaches that the alleged merge utility receives EMF documents and that the printer receives RAW documents. Thus, *Schwier* does not teach that the merge utility receives at least one document <u>in the same format</u> as does the output device. *Schwier* therefore fails to teach at least one of the steps of "receiving, at a merge utility executing on a computer system, a first merge document that is in a merge format" and "delivering said composite merge document to an output device," within the meaning of Claim 11.

For at least the foregoing reason, the combination of *Palmer* and *Schwier* fails to teach or suggest at least one feature of dependent Claim 11. Therefore, the combination of *Palmer* and *Schwier* does not render Claim 11 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

DEPENDENT CLAIMS 2–10, 12–28

Claims 2–28 depend from Claim 1, and include each of the above-quoted features by dependency. Thus, the combination of *Palmer* and *Schwier* also fails to teach or suggest at least one feature found in Claims 2–28. Therefore, the combination of *Palmer* and *Schwier* does not render obvious Claims 2–28. Reconsideration of the rejection is respectfully requested.

In addition, each of Claims 2–28 recites at least one feature that independently renders it patentable. For example, **Claim 13** features, among other elements:

> receiving, at the merge utility, a request to merge documents;
> wherein the steps of **converting** the second document and merging
> the first merge document and the second merge document
> are both performed **in response** to the merge utility
> receiving the request to merge documents.

The Office Action alleges that these steps are taught in *Schwier* col. 6, lines 8–18. The Office Action is mistaken. This passage says nothing about performing the "step[] of **converting** the

second document" from the original format to the merge format **"in response" to the "request**
to merge documents."

As another example, **Claim 9** features, among other elements:

> passing [a] set of conversion instructions from the merge utility to the first
> document authoring application; and
> the first document authoring application generating the second merge document
> based on said set of conversion instructions.

The Office Action alleges that "passing [a] set of conversion instructions to a document
authoring application" may be found in *Schwier*, col. 4, lines 15-20. However, this portion of
Schwier does not show **a merge utility passing a set of instructions**, as Claim 9 presently
recites. Even more specifically, Claim 9 requires that merge utility pass the instructions to the
document authoring application **that created the second document**. *Schwier* does not disclose
or suggest anything like this.

As another example, **Claim 12** recites that the **"composite merge document** is a
template for creating other documents." The Office Action alleges that *Schwier* discloses this
feature by virtue of the fact that Figure 5 of *Schwier* shows a master document. However, the
master document of Figure 5 in *Schwier* is not a composite merge document. While Figure 5
does show a master document, this master document is not merged from two documents in the
merge format, as is a composite merge document. Rather, the master document of Figure 5 is
created at a document authoring program, and will subsequently be separated into static data and
variable data. At no point does *Schwier* disclose a composite merge document behaving as a
template.

To expedite prosecution in light of the fundamental differences already identified, further
arguments for each independently patentable feature of Claims 2–28 are not provided at this
time. Applicants reserve the right to further point out the differences between the cited art and
the novel features recited in the dependent claims.

II.   ADDED CLAIM

Claim 29 has been added. Claim 29 is supported by the original Specification and
therefore adds no new matter to the application. Claim 29 depends upon Claim 1, and is
patentable over the cited references for at least the reason that Claim 1 is patentable.

III.   CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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